



REISSUE APPLICATION BY THE ASSIGNEE, OFFER TO SURRENDER PATENT

Docket Number (Optional)
CONT1013

| Name of Patentee(s): | oplication for a reissue pate | | | |
|--|--|---|--|--|
| | Richard Chao | | | |
| Patent Number | | Date Patent Issued | | |
| | 5,568,207 | | October 22, 1996 | |
| Title of Invention | AUXILIARY LENSES | AUXILIARY LENSES FOR EYEGLASSES | | |
| Contour Opt: | is the | assignee of the entire i | nterest in the original patent. | |
| I offer to surrender t | the original patent. | | | |
| XX The reel a | and frame number of | the assignment | being: | |
| Reel 83 | 334, frames 0766-7 | | | |
| I am authorized to | act on behalf of the assign | ee. | | |
| were made with the k fine or imprisonment, | mowledge that willful false or both, under 18 U.S.C. 1 or both, under 18 U.S.C. 1 or the application, any pate | pelieved to be true; and statements and the like 001 and that such willfu | further that these statements so made are punishable by all false statements may | |
| Name of assignee | Contour Optik, I | nc | | |
| Signature of person of | | | | |
| Signature of person si | gning for assignee | Date | .0.00 | |
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| Typed of printed name | and title of person signing | for assignee | TERNATIONAL SALES | |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application

Inventor: Richard Chao

Reissue Application No.: Unknown

Reissue Application No.: Unknown

Filed: Herewith

Patent No.: 5,568,207

Title: AUXILIARY LENSES FOR EYEGLASSES

PREISSUE PATENT APPLICATION

REISSUE PATENT APPLICATION

Art Unit: Unknown

Examiner: Unknown

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Art Unit: Unknown

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CERTIFICATE OF MAILING BY "EXPRESS MAIL" UNDER 37 C.F.R. §1.10

"Express Mail" mailing label number:TB687080988US Date of Mailing: October 21, 1998.

I hereby certify that this correspondence is being deposited with the United States Postal Service, utilizing the "Express Mail Post Office to Addressee" service addressed to Assistant Commissioner for Patents, Washington, DC 20231 and mailed on the above Date of Mailing with the above "Express Mail" mailing label number.

(Signature)

Peter P. Tong
Signature Date: October 21, 1998.

REISSUE APPLICATION DECLARATION OF RICHARD CHAO AND POWER OF ATTORNEY

Box DAC Assistant Commissioner for Patents Washington, D.C. 20231

Sir:

I, Richard Chao, hereby declare that:

1. I am the sole inventor of the subject matter described and claimed in the attached U.S. Patent No. 5,568,207, issued on October 22, 1996, for an invention entitled, "Auxiliary Lenses for Eyeglasses" (the "Patent"), for which invention I solicit a reissue patent.

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Attorney Docket No.: CONT1013REI1SRM/PPT ppt/cont/1013-1.001

207.001:100396

- 2. I am a citizen of Taiwan, R.O.C., and my address is No. 43-4, Yi Hsin Tsuen, Shui San Hsiang, Chia Yi Hsien, Taiwan.
- 3. I have reviewed and understand the contents of the above identified specification, including the claims.
- 4. I acknowledge the duty to disclose information that is material to the examination of this application (the "Reissue Application"), namely, information where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the Reissue Application to issue as a patent. In compliance with this duty, there is attached an information disclosure statement in accordance with 37 CFR 1.98.
- 5. I believe the Patent to be partly inoperative because of errors without any deceptive intent on my part.

The statement below specifies the errors relied upon, and how they arose (37 CFR 1.175(a)(5)), namely, why the Patent is believed to be partly inoperative (37 CFR 1.175(a)(1)); and more distinctly, the excess or insufficiency in the claims that make the patent partly inoperative "by reason of the patentee claiming less than he had a right to claim in the patent" (37 CFR 1.175(a)(3)).

As hereinafter more fully explained, I believe that through error, without any deceptive intent, subject matter was disclosed in the figures of the Patent, but not described in text; and vice versa. Though the Patent was not appropriately claimed, the disclosed figures and text show my intent to claim. The circumstances giving rise to the aforesaid error, to the best of my information and belief, are set forth below.

- 6. At the time the application for the Patent was being prepared (the "Original Application"), I requested that the Original Application protect my magnetic frames invention. I provided my Taiwan patent counsel with sketches and descriptions, and requested the Original Application preparation move forward. My Taiwan patent counsel ensured me that my invention would be protected. I was not versed in patent application and patent law. As a result, I posited the utmost trust in my Taiwan patent counsel to ensure that my invention would be safeguarded.
- 7. When the Original Application was completed, I reviewed it and understood the disclosure with the claims. I relied upon my Taiwan patent counsel's assurances that my invention would be protected in the market place based on the Original Application as prepared.
- Mhile I understood the disclosure and the claims, I was not really able to thoroughly understand US patent law and procedure. For example, I believed that as long as an embodiment was in the disclosure, such as in the figures or the detailed description of the preferred embodiment, of the Patent, I would have got protection for it. At all times during the preparation and prosecution of the Original Application, I was assured by my Taiwan patent counsel that the Original Application would protect my invention.
 - 9. The Patent was allowed and issued on October 22, 1996.

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- Recently, my Patent has been opposed by third parties. Specifically, as shown in the attached German opposition (Appendix I), Pentax Vision Co. (hereinafter "Pentax") opposed to the grant of the Patent's corresponding German patent. Also, the U.S. Patent and Trademark Office has notified me that an interference has been declared on my Patent. A copy of the declaration is enclosed (Appendix II). Both of these events have caused me to be concerned that the Patent may be partly inoperative by reason of my inappropriate claiming, including claiming less than what I have a right to claim.
- 11. Based on further investigation, I was advised that my Taiwan patent counsel failed to appreciate the full scope and breadth of the invention. I should both broaden and narrow my claims.
- I was advised, for example, that (1) I should include as dependent claims magnetic members being magnets; (2) I should include as dependent claims two upper side portions, and the gap between the first magnetic members and the second magnetic members; (3) I should claim magnetic members engaging on a horizontal position; (4) I should claim primary spectacle frames without auxiliary frames; (5) I should claim auxiliary frames without primary spectacle frames; (6) I should include as dependent claims the end portion of an arm extending downward for hooking on the primary spectacle frame; and (7) I should broaden the issued Claim 1.
- 13. I was also advised that I should (a) Describe one embodiment disclosed in FIG. 7 of the Patent, for example, the magnetic members 14 and 22 not being in contact with each other, the arm 21 being supported on an upper side portion of the primary spectacle frame 10, and the upper side portion being an upper part of the side portion securing the projection 13; and (b) Include a new FIG. 8 illustrating one embodiment of "the end portions of the arms 21 ... extended downward toward the projections 13 such that the arms 21 ... may hook on the primary spectacle frame 10..." See Col. 3, lines 4-7 of the specification.
- 14. I was further advised of the ability to seek reissue of my invention in the Patent in order to correct the errors.
- Failure to describe embodiments shown in the figure and the text, and to suggest broader and narrower claim language were errors. They resulted from the fact that I did not understand the procedure of patent prosecution and the law of patent. The errors occurred without any deceptive intent on my part, nor do I believe that there was any deceptive intent on the part of any other person.
- 16. I also believe that the invention as claimed in this Reissue Application was disclosed in the Patent, and no new matter has been introduced in this Reissue Application.
- 17. I believe that this Reissue Application seeks to correct the above-described errors through the following changes:

Add a new FIG. 8, as attached.

A new informal FIG. 8 is submitted herewith. Upon the acceptance of the figure, a formal FIG. 8 will be submitted.

At column 2, line 30, insert a new paragraph as follows:

--FIG. 8 illustrates another embodiment of a cross sectional view taken along lines 7-7 of FIG. 6.--

At column 3, line 10, insert at the end of the line the following:

--In one embodiment, as shown in FIG. 7, magnetic members 14 and 22 are not in contact with each other, magnetic members 14 and 22 are engaged with, but not supported on, each other. Instead, the arm 21 securing the magnetic member 22 is supported on an upper side portion of the primary spectacle frame 10. As shown in FIG. 7, the upper side portion can be an upper part of the side portion securing the projection 13.--

Amend Claim 1 and Add new claims 3-35 as follows:

1. (Once Amended) An eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein, said primary spectacle frame including two side portions each having an extension extended therefrom for pivotally coupling a leg means thereto, said primary spectacle frame including two rear and side portions each having a projection secured thereto, said primary spectacle frame including an upper side portion,

a pair of first magnetic members secured in said projections respectively, an auxiliary spectacle frame for supporting auxiliary lenses therein, said auxiliary spectacle frame including two side portions each having an arm extended therefrom, with at least one arm for extending over [and for engaging with] said upper side portion of said primary spectacle frame, and

a pair of second magnetic members secured to said arms respectively for engaging with said first magnetic members of said primary spectacle frame soas to secure said auxiliary spectacle frame to said primary spectacle frame,

at least one of said arms being [engaged with and] supported on said upper side portion of said primary spectacle frame so as to allow said auxiliary spectacle frame to be stably supported on said primary spectacle frame and so as to prevent said auxiliary spectacle frame from moving downward relative to said primary spectacle frame and so as to prevent said auxiliary spectacle frame from being disengaged from said primary spectacle frame.

- 3. (New) An eyeglass device as recited in claim 1 wherein the first and the second magnetic members are magnets.
- 4. (New) An eyeglass device as recited in claim 1 wherein:
 the primary spectacle frame includes two upper side portions, each upper side portion for supporting one of said arms.
- 5. (New) An eyeglass device comprising:
 a primary spectacle frame for supporting primary lenses therein;
 the primary spectacle frame including two side portions;

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each side portion having an extension extended therefrom for pivotally coupling a leg thereto;

the primary spectacle frame including a projection extending from each said side portion;

each projection securing a first magnetic member; and the primary spectacle frame including an upper portion; and

an auxiliary spectacle frame for supporting auxiliary lenses therein; the auxiliary spectacle frame including two auxiliary side portions; each said auxiliary side portion having an arm extended therefrom, with at least one arm being configured to extend over the upper portion of the primary spectacle frame;

each arm securing a second magnetic member;

each second magnetic member configured to engage with one of the first magnetic members of the primary spectacle frame; and

the upper portion supports at least one arm of the auxiliary frame.

- 6. (New) An eyeglass device as recited in Claim 5 wherein the upper portion is an upper part of one of the side portions.
- 7. (New) An eyeglass device as recited in Claim 5 wherein the first and the second magnetic members are magnets.
- 8. (New) An eyeglass device as recited in Claim 7 wherein the first magnetic members are not in contact with the second magnetic members.
- 9. (New) An eyeglass device as recited in Claim 8 wherein the upper portion is an upper part of one of the side portions.
- 10. (New) An eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein; the primary spectacle frame including two side portions;

each side portion having an extension extended therefrom for pivotally coupling a leg thereto;

the primary spectacle frame including a projection extending from each said side portion;

each projection securing a first magnetic member; and the primary spectacle frame including an upper means; and

an auxiliary spectacle frame for supporting auxiliary lenses therein; the auxiliary spectacle frame including two auxiliary side portions; each said auxiliary side portion having an arm extended therefrom; with at least one arm being configured to extend over the upper means of the primary spectacle frame;

each arm securing a second magnetic member;

each second magnetic member configured to engage with one of the first magnetic members of the primary spectacle frame; and

the upper means supports at least one arm of the auxiliary frame.

- 11. (New) An eyeglass device as recited in claim 10 wherein: the first and the second magnetic members are magnets; and the upper means is an upper part of one of the side portions.
- 12. (New) An eyeglass device comprising:

a primary frame for supporting primary lenses therein; the primary spectacle frame including two side portions;

each side portion having an extension extended therefrom for pivotally coupling a leg thereto; and

the primary spectacle frame including two first magnets, each secured to one of the side portions of the primary frame; and

an auxiliary frame for supporting auxiliary lenses therein, and for disposing in front of the primary frame;

the auxiliary spectacle frame including two auxiliary side portions; and the auxiliary frame including two second magnets, each secured to one of the auxiliary side portions, for engaging on a horizontal position with one of the first magnets so as to secure the auxiliary frame to the primary frame.

13. (New) An eyeglass device as recited in Claim 12 wherein:

the primary spectacle frame includes a projection extending from each of its side portion;

each projection secures one of the first magnets;

the primary spectacle frame includes an upper portion;

each said auxiliary side portion has an arm extended therefrom;

at least one arm is configured to extend over the upper portion of the primary spectacle frame;

each arm secures one of the second magnets; and the upper portion is an upper part of one of the side portions.

14. (New) A primary eyeglass device adapted to stably support an auxiliary spectacle frame, which includes two auxiliary side portions, each auxiliary side portion having an arm extended therefrom, and each arm securing a first magnetic member,

the primary eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein;

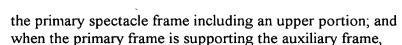
the primary spectacle frame including two primary side portions;

each side portion having an extension extended therefrom for pivotally coupling a leg thereto;

the primary spectacle frame including a projection extending from each said side portion;

each projection securing a second magnetic member;





each second magnetic member engages with one of the first magnetic members;

the upper portion being extended over by at least one arm of the auxiliary frame; and

the upper portion supports at least one arm of the auxiliary frame.

- 15. (New) A primary eyeglass device as recited in Claim 14 wherein the upper portion is an upper part of one of the primary side portions.
- 16. (New) An auxiliary eyeglass device comprising:
 an auxiliary spectacle frame for supporting auxiliary lenses therein;
 the auxiliary spectacle frame including two auxiliary side portions;
 each auxiliary side portion having an arm extended therefrom; and
 each arm securing a first magnet;

the auxiliary spectacle frame being adapted to be stably supported on a primary spectacle frame, which includes two primary side portions, each side portion securing a second magnetic member, the primary spectacle frame also including an upper portion; and

when the auxiliary frame is supported by the primary frame,

each first magnet engages with one of the second magnetic members; and

at least one arm of the auxiliary frame extending over the upper portion.

- 17. (New) An auxiliary eyeglass device as recited in Claim 16 wherein when the auxiliary frame is supported by the primary frame, at least one arm of the auxiliary frame is supported by the upper portion of the primary frame, which is an upper part of one of the primary side portions.
- 18. (New) An auxiliary eyeglass device adapted to be stably supported on a primary spectacle frame, which includes two primary side portions, each said side portion securing a first magnetic member, the primary spectacle frame also including an upper portion, the auxiliary eyeglass device comprising:

an auxiliary spectacle frame for supporting auxiliary lenses therein; the auxiliary spectacle frame including two auxiliary side portions; each auxiliary side portion having an arm extended therefrom; each arm securing a second magnet; and when the auxiliary frame is supported by the primary frame,

each second magnet engages with one of the first magnetic members of the primary spectacle frame; and

at least one arm of the auxiliary frame extending over the upper portion.

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- 19. (New) An auxiliary eyeglass device as recited in Claim 18 wherein when the auxiliary frame is supported by the primary frame, at least one arm of the auxiliary frame is supported by the upper portion of the primary frame, which is an upper part of one of the primary side portions.
- 20. (New) A primary eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein; the primary spectacle frame including two primary side portions;

each side portion having an extension extended therefrom for pivotally coupling a leg thereto;

the primary spectacle frame including a projection extending from each said side portion;

each projection securing a first magnet; and the primary spectacle frame including an upper portion;

the primary frame adapted to stably support an auxiliary spectacle frame, which includes two auxiliary side portions each securing a second magnetic member; and

when the primary spectacle frame is supporting the auxiliary spectacle frame.

the upper portion is extended over by at least one of the auxiliary side portions;

the upper portion supports at least one of the auxiliary side portions; and

each first magnet engages with one of the second magnetic members.

- 21. (New) A primary eyeglass device as recited in Claim 20 wherein the upper portion is an upper part of one of the primary side portions.
- 22. (New) A primary eyeglass device adapted to stably support an auxiliary spectacle frame, the auxiliary spectacle frame for supporting auxiliary lenses therein, and for disposing in front of the primary frame, the auxiliary spectacle frame including two auxiliary side portions, each auxiliary side portion having an arm extended therefrom, and each arm securing a first magnet,

the primary eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein; the primary spectacle frame including two side portions;

each side portion having an extension extended therefrom for pivotally coupling a leg thereto;

the primary spectacle frame including a projection extending from each said side portion;

each projection securing a second magnet; and

when the primary frame is supporting the auxiliary frame, each second magnet is coupled to, but not in contact with, one of the first magnets on a horizontal position so as to secure the auxiliary frame to the primary frame.

- 23. (New) An eyeglass device as recited in Claim 4 wherein each upper side portion is an upper part of one of the side portions of the primary spectacle frame.
- 24. (New) An eyeglass device as recited in Claim 23 wherein the magnetic members are magnets.
- 25. (New) An eyeglass device as recited in Claim 1 wherein at least the end portion of one arm extends downward toward one of the projections for hooking on the primary spectacle frame so as to further stably support and secure the auxiliary spectacle frame to the primary spectacle frame.
- 26. (New) An eyeglass device as recited in Claim 5 wherein at least the end portion of one arm extends downward toward one of the projections for hooking on the primary spectacle frame such that the auxiliary spectacle frame is further stably supported and secured to the primary spectacle frame.
- 27. (New) An eyeglass device as recited in Claim 10 wherein at least the end portion of one arm extends downward toward one of the projections for hooking on the primary spectacle frame such that the auxiliary spectacle frame is further stably supported and secured to the primary spectacle frame.
- 28. (New) An eyeglass device as recited in Claim 12 wherein at least the end portion of one auxiliary side portion extends downward toward one of the side portions of the primary spectacle frame for hooking on the primary spectacle frame such that the auxiliary spectacle frame is further stably supported and secured to the primary spectacle frame.
- 29. (New) An auxiliary eyeglass device as recited in Claim 16 wherein when the auxiliary frame is supported by the primary frame, at least the end portion of one arm extends downward toward one of the side portions of the primary spectacle frame for hooking on the primary spectacle frame such that the auxiliary spectacle frame can be further stably supported and secured to the primary spectacle frame.
- 30. (New) An auxiliary eyeglass device as recited in Claim 18 wherein when the auxiliary frame is supported by the primary frame, at least the end portion of one arm extends downward toward one of the side portions of the primary spectacle frame for hooking on the primary spectacle frame such that the auxiliary spectacle frame can be further stably supported and secured to the primary spectacle frame.
- 31. (New) An eyeglass device as recited in claim 25 wherein the first and the second magnetic members are magnets.
- 32. (New) An eyeglass device as recited in claim 26 wherein the first and the second magnetic members are magnets.

33. (New) An eyeglass device as recited in claim 27 wherein the first and the second magnetic members are magnets.

34. (New) An eyeglass device comprising:

a primary frame for supporting primary lenses therein; the primary spectacle frame including two side portions; each side portion having an extension extended therefrom for pivotally coupling a leg thereto; and

the primary spectacle frame including two first magnets, each secured to one of the side portions of the primary frame, and

an auxiliary frame for supporting auxiliary lenses therein, and for disposing in front of the primary frame;

the auxiliary spectacle frame including two auxiliary side portions, and

the auxiliary frame including two second magnets, each secured to one of the auxiliary side portions, for coupling on a horizontal position with one of the first magnets so as to secure the auxiliary frame to the primary frame.

35. (New) An eyeglass device comprising:

a primary frame for supporting primary lenses therein; the primary spectacle frame including two side portions;

each side portion having an extension extended therefrom for pivotally coupling a leg thereto; and

the primary spectacle frame including two first magnetic members, each secured to one of the side portions of the primary frame; and

an auxiliary frame for supporting auxiliary lenses therein, and for disposing in front of the primary frame;

the auxiliary spectacle frame including two auxiliary side portions; and

the auxiliary frame including two second magnetic members, each secured to one of the auxiliary side portions, for coupling on a horizontal position, but not in contact, with one of the first magnets so as to secure the auxiliary frame to the primary frame.

18. As a result of these corrections, the amended claim, the new claims and the amended specification more closely represent my invention. The specification and the claims in the Patent caused the Patent to be partly inoperative. My invention is better represented by the amended specification, the amended claim, and the new claims for reissue.

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POWER OF ATTORNEY

As the sole named inventor, I hereby appoint the following attorneys to prosecute and transact all business in the U.S. Patent and Trademark Office regarding this Reissue Application: Sheldon R. Meyer, Reg. No. 27,660, and Peter P. Tong, Reg. No. 35,757.

Please address all correspondence to:
Sheldon R. Meyer
FLIESLER, DUBB, MEYER & LOVEJOY LLP
Four Embarcadero Center, Suite 400
San Francisco, CA 94111-4156

Please direct all telephone calls to: Peter P. Tong (415) 362-3800

I hereby declare that I am authorized to sign for Contour and that all statements made herein of my knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the Reissue Application and any patent issuing thereon.

Full Name:

Richard Chao

Signature:

Dated: 10-18.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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FLIESLEH, DUBB, MEYER & LOVEJOY

In re Relesue Application

Inventor:

Richard Chao

Reissue Application No.: Unknow

Filed:

Hernyvith

Patent No.: 5,598,207

Times

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EVEGLASSES

Art Unit:

Unknown

Examiner:

Unknown

#4

ASSENT OF ASSIGNEE

Assistant Commissioner for Potents Washington, DC 20231

Sim

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Republic of Chira, is the sole Assignee of United states Patent No. 5,568,207, granted on October 22, 1996, by an assignment executed by the inventor Richard Chao and in the United States Patent and Trademark Office of Reel 8334, Frames 0766-7, and hereby assents to the reissue of United States Patent No. 5,568,207. The attached evidentiary documents have been reviewed and Assignee certifies that to the best of Assignee's knowledge and belief, title to the above-identified application is in Assignee.

Increby declare that I am nuthorized to sign for Contour Optik. Inc. and that all statements made herein of my knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable

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by fine or imprisonment, or both, under Section 1001, Title 18 of the United states Code, and that such willful false statements may jeopardize the validity of the application and any patent issuing thereon.

CONTOUR OPTIK, INC.

Date: October 21, 1998.

 David Chao

Director of International Sales